SEP 2 1944
CHARLES ELMORE CROPLEY
CLERK

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1944

No. 424

THE UNITED STATES,

Appellant,

vs.

DAVID McD. SHEARER.

APPEAL FROM THE COURT OF CLAIMS.

STATEMENT OPPOSING JURISDICTION AND MOTION TO DISMISS OR AFFIRM.

CLARENCE B. DES JARDINS,
Counsel for Appellee.

INDEX.

Table of Cases Cited.

	Page
Assiniboine Indian Tribe v. *United States*, 292 U. S. 606	2
Atlantic Works v. *Brady*, 107 U. S. 192	24
Colgate v. *United States*, 280 U. S. 43	2
Goltra v. *United States*, 312 U. S. 203	22
United States v. *Esnault-Pelterie*, 303 U. S. 26	14
United States v. *Goltra*, 312 U. S. 203	5
Williams Mfg. Co. v. *United Shoe Machinery Corp'n*, 316 U. S. 364	14

Statutes Cited.

Act of June 25, 1910, 35 U. S. Code, 68	10
Judicial Code, Sec. 237(c), 28 U. S. Code 344(c)	7

Text Cited.

Robertson and Kirkham, Jurisdiction of the Supreme Court of the United States, Sec. 219, p. 375	2

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1944

No. 424

THE UNITED STATES,

Appellant,

vs.

DAVID McD. SHEARER,

Appellee.

APPEAL FROM THE COURT OF CLAIMS.

APPELLEE'S STATEMENT OPPOSING JURISDICTION AND MOTION TO DISMISS OR AFFIRM.

Statement by appellee of grounds in opposition to appellate jurisdiction, pursuant to Supreme Court Rule 12.

The appellee states the following matters and grounds against the jurisdiction of this Court, as asserted by the appellant herein, and its statement of the basis of the appellate jurisdiction, filed in the Court of Claims on the 26th day of July, 1944, as required by Rule 12 of the Supreme Court.

I. Private Act No. 285, 71st Congress, approved December 17, 1930, under which this suit was brought and on

which appellant relies to sustain the appellate jurisdiction of this Court, does not confer jurisdiction on the Supreme Court to review the judgment herein by direct appeal. It provides, merely, for review by certiorari upon a petition for certiorari filed within ninety days after the rendition of the judgment. In support of this contention, the appellee cites the following authorities:

Colgate v. *United States,* 280 U. S. 43;

Assiniboine Indian Tribe v. *United States,* 292 U. S. 606;

Robertson and Kirkham, Jurisdiction of the Supreme Court of the United States, Sec. 219, p. 375.

In the case at bar, the provision of the Private Act, as to review of the judgment of the Court of Claims, is, as follows:

> "Either party may appeal to the Supreme Court of the United States upon any such questions where appeals now lie in other cases, arising during the progress of the hearing of said claim, and from any judgment in said case, at any time within ninety days after the rendition thereof; and any judgment rendered in favor of the claimant shall be paid in the same manner as other judgments of said Court of Claims."

This language expresses the clear intent that either party might appeal to this Court, "upon any such question where appeals now lie in other cases", whether the question arose during the hearing or on final judgment. Of course, at the date of approval of the Private Act, December 17, 1930, there was no right of direct appeal to this Court from judgments of the Court of Claims, "in other cases."

In *Colgate* v. *United States, supra,* this Court dismissed an appeal by the plaintiff from a judgment of the Court of Claims in a suit, brought under a Special Act, based on a claim for alleged patent infringement. The provision of

the Special Act, as to review of the judgment, was, as follows (p. 44):

> "*Provided,* That either party hereto may appeal to the Supreme Court of the United States upon or from any conclusion of law or judgment, from which appeals now lie in other cases, at any time within ninety days after the rendition of judgment: * * *"

This Court held that the foregoing provision did not confer the right of a direct appeal from the judgment of the Court of Claims, but contemplated merely a review on writ of certiorari. The Court said (p. 45):

> "We think the proper construction to be put upon this Special Act is that the review provided for was a petition for certiorari. One of the chief purposes of the General Act of February 13, 1925, ch. 229, 43 Stat. 936, was to abolish appeals from the Court of Claims to this Court and substitute therefor applications for writs of certiorari. The language of the Special Act is that 'either party hereto may appeal to the Supreme Court of the United States upon or from any conclusion of law or judgment *from which appeals now lie in other cases.*' At the time of the passage of that Act, no appeals generally 'lay in other cases' from the Court of Claims to this Court, and do not now. It was evidently intended by the Act of 1925 to make the method of review by this Court of judgments of the Court of Claims, uniform. It was intended by the Act of 1925 to give this Court an opportunity to determine in advance whether the case was one worthy of review here. To hold that the case may come here only by certiorari is to make it conform to the general purpose of the Act of February 13, 1925, in enlarging the use of certiorari as a method of review in this Court. To describe appeals as from judgments 'from which appeals now lie in other cases' is a mistake, unless one gives to the meaning of the word 'appeals' something more than a mere technical meaning. If what was intended was an appeal in its

technical significance as distinguished from certiorari, different words should have been used to indicate it. Therefore the Special Act must be construed to require that the review intended was the usual method of review at the date of the Special Act, which is and was by application for a writ of certiorari.

* * * * * * *

These provisions with respect to special review of cases from the Court of Claims should be carefully construed. They are generally embodied in exceptional legislation considered by other committees than the judiciary committees, not especially advised as to the importance of uniformity in respect to such exceptions. It should therefore, be clear, if a departure from the ordinary methods of limitation of review is intended by Congress, that the language should leave no doubt about it.

The history of the legislation and the language used show that the reference to appeals in the Special Act now before us finds its counterpart in other Acts having the same purpose. The language is that 'either party hereto may appeal to the Supreme Court of the United States upon or from any conclusion of law or judgment from which appeals now lie in other cases.' Acts of this kind, although speaking of 'appeals,' show what is intended by the phrase, 'as in other cases.'

* * * * * * *

Here are included five instances in which the expression used describing the appeal is as one which would 'lie in other cases,' and the whole course of the legislation indicates a desire that the same appellate review should be given as in other cases. We think that this customary language requires the uniform use of the writ of certiorari in order to secure that which a certiorari gives—a preliminary examination of proceedings by this Court before review. Unless a special reason in the Act providing for appellate review indicates that the review is to be by technical appeal rather than

> by the ordinary method of certiorari, the latter method is the right one. This must lead to the dismissal of the present appeal."

The language used by Congress, in Private Act No. 285, in providing for review, is so similar to that under consideration in the *Colgate* case, that the decision of this Court in that case is applicable to the case at bar. The attempt of appellant to construe the words, "where appeals now lie in other cases," as applying only to interlocutory questions, results in a forced and unnatural construction of the entire provision. In the case at bar the words, "where appeals now lie in other cases", indicate the usual mode of review, just as was indicated, in the *Colgate* case, by the words, "from which appeals now lie in other cases."

The fact that the time within which a party may appeal is fixed at ninety days, instead of three months, is not significant. It certainly does not suggest a direct appeal, as distinguished from review on writ of certiorari. Moreover, the limit of appeal was fixed at ninety days in the Special Act involved in the *Colgate* case. "Ninety days" and "three months" are usually considered as meaning the same thing.

In *Assiniboine Indian Tribe* v. *United States, supra,* the appeal from the Court of Claims was dismissed, on the authority of *Colgate* v. *United States, supra.* The Special Act in the *Assiniboine* case, as appears from the report of the decision below in 77 Ct. Cls. 347, provided, as follows:

> "That jurisdiction be, and is hereby, conferred upon the Court of Claims, with right of appeal to the Supreme Court of the United States, by either party, * * *."

The decision in *United States* v. *Goltra,* 312 U. S. 203, does not sustain the appellate jurisdiction of this Court, in the

present case. There, the Special Act provided, as follows (p. 205):

> "That either party may appeal as of right to the Supreme Court of the United States from any judgment in said case at any time within ninety days after the rendition thereof, and any judgment rendered in favor of the claimant shall be paid in the same manner as other judgments of said Court of Claims are paid."

This Court, in the first footnote on page 204, distinguished from the decisions in the *Colgate* and *Assiniboine* cases, saying:

> "The inclusion of the phrase 'as of right' in the jurisdictional act sufficiently makes clear the intention of Congress to authorize either party to take a technical appeal to this Court."

The words "as of right", or words of similar import, do not appear in Private Act No. 285, here under consideration. There is no basis, here, for the distinction given effect in the *Goltra* case. House Report No. 763, 71st Congress, on the special jurisdictional act in this case (printed as an appendix to the Findings and Decision of the Court of Claims, dated March 7, 1938), does not indicate any intent to give either party a right of direct appeal to the Supreme Court.

It is submitted, therefore, that there is no right of direct appeal to this Court, in the present case, and that the appeal should be dismissed for want of jurisdiction.

Comes now David McD. Shearer, the appellee herein, by Clarence B. Des Jardins, his counsel, and moves this Court to dismiss the appeal taken herein to this Court by The United States, appellant, upon the following grounds:

I. There is no right of direct appeal to the Supreme Court to review judgments of the Court of Claims.

II. Private Act No. 285, 71st Congress, approved December 17, 1930, under which this suit was brought and on which appellant relies to sustain the appellate jurisdiction of this Court, does not confer jurisdiction on the Supreme Court to review the judgment herein by direct appeal, but provides, merely, for review by writ of certiorari upon a petition for certiorari filed within ninety days after rendition of the judgment. No such petition has been filed and the ninety days have expired.[1]

In support hereof, appellee refers to his statement of grounds in opposition to appellate jurisdiction, herein contained.

In the alternative, appellee moves this Court to affirm the judgment from which this appeal purports to have been taken, on the ground that it is manifest that the said appeal was taken for delay only, that no substantial questions of law are involved, and that the appeal seeks only to require this Court to review the findings of fact of the Court of Claims herein.

Nature of the Case and Rulings Below.

Plaintiff was employed by the United States, under the Mississippi River Commission, from 1910 until May, 1917, when he left this employment to become a candidate for a commission in the United States Army. He received that commission and continued to serve as an officer in the Engineer Corps of the United States Army, until long after the present suit was brought. At the time of Shearer's employment by the Mississippi River Commission, the subaqueous banks of the Mississippi River were protected by means of so-called willow mattresses. These were formed

[1] It is thought that Sec. 237(c) of the Judicial Code (28 U. S. Code 344c) has no application to an appeal from the Court of Claims, under a special jurisdictional act.

by weaving together bundles of willow brush to form a raft, which was floated on the river to position over the portion of the subaqueous bank to be protected and, then, sunk by dumping stone or ballast thereon. Plaintiff served as chief of a revetment party and, in such position, he had charge of the construction and sinking of willow fascine mattresses by his party. While so engaged, Shearer became convinced that there were serious disadvantages attending the use of willow brush for the construction of mattresses to protect the subaqueous banks and suggested to his superior the advisability of study for the purpose of developing a concrete mattress which would serve the same purpose more satisfactorily. He was not ordered or encouraged to do this and, therefore, proceeded to study the matter, in his spare time, when he was not engaged in official duties. As the result of this study by him, outside his working hours and at his own expense, he conceived and developed three related inventions which are set forth in and covered by the three patents involved in this suit. One of these inventions was a form of articulated concrete mattress or revetment which would protect the subaqueous banks more satisfactorily than the willow mattress, and could be constructed and laid in place, that is to say, was capable of being launched, even in strong currents and deep water, in an inexpensive, relatively quick, and completely reliable manner. This is covered by Shearer patent, No. 1,173,879. The second invention was of a launching apparatus for the purpose of constructing and launching the articulated concrete mats of his revetment patent. This was covered by his patent, No. 1,229,152. The third invention was of a particular form of mold for use in casting the concrete sections, which were to be united to form the articulated concrete mats. This was covered by his patent, No. 1,173,880.

Having conceived these several inventions, and worked out the details thereof to the finished state shown in his several patents involved in this suit, Shearer submitted them to his superior officer, Mr. Hider. They were submitted under an understanding with Mr. Hider that, if adopted by the Government, an arrangement would be made to compensate Shearer for the use thereof. At Mr. Hider's suggestion, plaintiff prepared drawings showing a modification of his ideas, which was particularly adapted for use, with a minimum of expense, by converting one of the standard willow mat boats. These drawings and the specifications attached were formally submitted, through Mr. Hider, on October 6, 1914. Sometime thereafter, Shearer was assigned by Major Slattery, who was in charge of the Engineer District, to the duty of supervising the changing over of one of the willow mat boats, for the purpose of conducting a test of the apparatus submitted on October 6, 1914. Before these preparations had been completed, Shearer was assigned to other duties and the work of supervising the completion of alterations to the brush mat boat was assigned by Major Slattery to A. J. Rife, who subsequently completed these preparations. This altered brush mat boat was tested during July, 1915, by laying concrete revetment therewith at Greenville, Mississippi. This Greenville test demonstrated the practicability of the Shearer inventions, although difficulties were encountered, due to the modification of Shearer's original ideas to permit the willow brush mat boat to be used with a minimum of expense in changing it over. Thereafter, plaintiff was assigned the official duty of preparing drawings of an apparatus for launching concrete revetment, which embodied his full conception, and, thereupon, he copied his original drawings, made prior to October 6, 1914, and from these drawings had constructed an apparatus, which was tested successfully at Delta Point

in July, 1916. At the same time, he prepared drawings, copied from his original drawings, for a concrete launching barge known as Mat Boat 1608, which was completed and used, early in 1917, in placing articulated concrete revetment at Vicksburg, Mississippi and Red Fork, Arkansas, under Shearer's supervision and direction.

Plaintiff's patents on the revetment and the mold, Nos. 1,173,879 and 1,173,880, were issued on February 29, 1916, and his patent, No. 1,229,152, on the launching boat, was issued on June 5, 1917. As soon as these patents issued, they were called by Shearer to the attention of his superior officers. The matter of awarding compensation to Shearer, for the use of his inventions, was up for consideration as early as January 20, 1917, which was before there was any substantial use of the inventions by the Government. On October 27, 1917, plaintiff made formal application to the Mississippi River Commission for the allowance of a royalty of 10% of the cost of construction of the revetment, as compensation for the use of his patented inventions.[2] This request was refused by the Commission, on the ground that the Act of June 25, 1910, prohibited the Commission from paying royalty or compensation for the use of patented devices developed while the patentee was in the pay of the Government.

The Act of June 25, 1910 (35 U. S. Code 68), providing for suit by a patentee in the Court of Claims to recover compensation for the unlicensed use of his patented invention by the United States, contained the following provisions:

> "The benefits of the provisions of this section shall not inure to any patentee who, when he makes such claim, is in the employment or service of the Government of the United States, or the assignee of any such patentee. This section shall not apply to any device dis-

[2] 98% of the articulated concrete revetment, for which plaintiff was awarded compensation, was laid after this formal claim for compensation.

covered or invented by such employee during the time of his employment or service."

This Act was not available to Shearer because he was in the employment or service of the Government of the United States, at the time of making his claim, and, also, because the devices, for which he claimed compensation, were discovered or invented by him during the time of his employment by the United States. Being debarred from taking advantage of this Act for those reasons, Shearer procured the passage of a Special Act for his relief, which was approved December 17, 1930, Private Act No. 285, 71st Congress. That Private Act vested the Court of Claims with jurisdiction "to hear and determine any statute limiting the time within which such an action may be brought to the contrary notwithstanding, first, whether the said David McD. Shearer was the first, original, and sole inventor of the inventions described in said letters patent or any of them; and if said court shall find that he was such first, original, and sole inventor of any of the same, then to determine, second, what amount of compensation, if any, he is justly entitled to receive from the United States for the use of his said inventions or any of them, since the date of said letters patent, up to the time of adjudication." The Court of Claims rightly construed this Private Act as referring Shearer's claim for compensation, for the unlicensed use of his patented inventions, to that court "to be adjudicated as other patent cases are under patent law". No defenses, available to the Government under the Act of June 25, 1910, were waived "except the statute of limitations and the prohibition of plaintiff's right to sue as expressed in the acts of 1910 and 1918".

The present suit was begun on January 16, 1932. The question of the amount of recovery, if any, having been reserved until after determination by the Court of Claims of the question of liability, that court, on March 7, 1938, filed

findings of fact, conclusions of law, and an opinion, in which it was held that claims 3 and 6 of Shearer patent, No. 1,173,879, were valid and had been infringed by the Government, that plaintiff was entitled to recover compensation for the unlicensed use of the invention covered by such claims, that claim 2 of Shearer patent, No. 1,229,152, was invalid, that claims 6, 8 and 9 of said patent were valid, that the defendant had used apparatus covered by such claims but that plaintiff was not entitled to recover for such use of the invention of claims 6, 8 and 9 of patent, No. 1,229,152, because the United States had an implied non-exclusive license to use the same, that claims 2 and 7 of Shearer patent, No. 1,173,880, were invalid and that plaintiff had withdrawn his claim for damages on account of an alleged infringement of said patent. On March 7, 1938 the Court of Claims entered a judgment dismissing the petition as to Shearer patents, Nos. 1,173,880 and 1,229,152, adjudging claims 3 and 6 of patent, No. 1,173,879, to be valid and infringed by the United States and that plaintiff was entitled to compensation therefor under the jurisdictional act, and referring the case to a commissioner to take testimony and report upon the question of reasonable and entire compensation.

On the accounting, additional evidence was produced before the commissioner and, on February 7, 1944, the Court of Claims filed findings of fact, conclusions of law, and an opinion, in which it was found that, during the accounting period, the defendant made and sank 887,981 squares[3] of articulated concrete revetment, covered by claims 3 and 6 of Shearer patent, No. 1,173,879, at a total cost of $12,524,620.40. It was found, as a fact, that the willow mat revetment constituted a reasonable standard of comparison for evaluating the Shearer inventions,

[3] Each square equals 100 square feet.

that being the type of revetment most extensively used by the Government during the accounting period and the nearest in cost to the articulated concrete revetment. The court below found that a fair and reasonable total monetary value of the benefits derived by the United States from the use of the two Shearer inventions, the articulated concrete revetment (patent No. 1,173,879) and the launching apparatus (patent No. 1,229,152) was $3.00 per square. It found that a reasonable allocation of this sum between the launching apparatus patent, as to which the Government had an implied license, and the revetment patent, as to which it had no license, was 39.6% to the former and 60.4% to the latter, or the sum of $1.81 per square of articulated concrete revetment. The Court of Claims further found, as a fact, that a fair and reasonable figure upon which to base compensation to the plaintiff, was 20% of the monetary value of $1.81 per square, or $0.36 per square. Finally, that court found, as a fact, that a reasonable compensation to the plaintiff for the use of his invention, patented by claims 3 and 6 of patent No. 1,173,879, was the sum of $319,673.16, plus interest at 5% per annum on specified sums from certain specified dates, such amounts not being added as interest "but as a part of the just compensation."

Defendant's motion for a new trial having been overruled, and plaintiff's motion for a new trial having been overruled, except as to the amendment of the conclusion of law filed February 7, 1944, to change the dates from which interest was calculated, a final judgment was entered May 1, 1944, awarding plaintiff $319,673.16, with an additional amount, measured by interest at the rate of 5% per annum on certain specified sums from certain specified dates. It is this judgment that the defendant seeks to review by this appeal.

for a patent embodied the same. The Mississippi River Commission adopted this patent and used the same.

The defendant inadvertently states in the brief 'No device embodying any of the alleged inventions was built, nor application filed until after April 1915.' The application for patent 1173879 was filed on December 30, 1914, and the patent was granted on February 29, 1916. Hence it is apparent that on December 30, 1914, the plaintiff had constructively reduced his patent to practice and his statutory monopoly dates from February 29, 1916. *Automatic Weighing Machine Co.* v. *Pneumatic Scale Corp.*, 166 Fed. 288, 297. *Telephone Cases*, 126 U. S. 1.

One defense interposed to the award of any compensation for the use by the Government of patent 1173879 is predicated upon the doctrine of a nonexclusive implied license to use the patent. No doubt the Government is entitled to assert such a defense; this is conceded. To sustain the contention reliance is had upon the proved facts and circumstances under which the Government did use the patent, deducing from these facts a conclusion that the Government by furnishing the funds and materials to construct the mats and subjecting them to tests after completion thereby enabled the plaintiff to develop his conception and obtain his patent, a proceeding in which the plaintiff acquiesced and in which he participated without claiming compensation at the time of user.

As we perceive it, the defense is vulnerable from the standpoint of law and fact. True, the defendant challenges the validity of the patent and infringement of the same. On these issues our decision is adverse. Therefore, under the cases cited the invention covered by plaintiff's patent 1173879 was developed and reduced to practice by him prior to defendant's tests which began in April 1915 and continued until 1916. It is one thing to subject a fully completed invention, well defined and covered by an application in the Patent Office, to tests in order to ascertain its availability for a particular use, and quite another to en-

gage in experiments and other activities to create and develop one.

The plaintiff did acquiesce in the tests and supervised them as stated in the findings. He was anxious and so was the defendant that they should demonstrate the utility of the mats. The tests did not demonstrate a need for any substantial change in mat construction, and as a matter of fact the principle embodied in their construction was then as it is now, and as it was on the date the plaintiff disclosed his conception to the officials of the Mississippi River Commission. The plaintiff sought compensation for the use of his patents soon after they were granted and his superior officer acknowledged their worth and would have compensated him if under the law he could have done so."

It is submitted that the Court of Claims committed no error of law or fact, in thus overruling the Government's defense of a non-exclusive, implied license as to Shearer patent, No. 1,173,879.

Resulting License

As stated above, the Court of Claims dismissed the petition as to Shearer patent, No. 1,229,152, on the launching apparatus, on the ground that the apparatus covered by claims 6, 8 and 9 of that patent had been used by the United States, under an implied non-exclusive license, for which use the United States was not liable under the special jurisdictional act. On the accounting, the defendant, for the first time, raised the contention that such implied, non-exclusive license, as to the launching apparatus patent, carried with it an implied license to use the invention of the revetment patent, No. 1,173,879. This contention was based upon the authorities which hold that, where the owner of a patent sells a licensee the right to use a patented machine, the grant of such license carries with it, by necessary implication, a license under any other patent of the

licensor, which would be infringed by the operation of the machine. That is a well-recognized principle, but it applies only where the original license was granted for a valuable consideration, that is to say, sold by the licensor. In the decision of February 7, 1944, the Court of Claims disposed of this contention, as follows (Preprint, p. 17):

> "Defendant bases its argument upon the principle that where the owner of a patent *grants or sells* to a licensee the right to use a patented machine, the grant carries with it, by necessary implication, a license under any other patent of the licensor which would be infringed by the operation of the machine. Such established principle is of itself sound and there are numerous cases which hold that one who has sold material or granted a license for a valuable consideration to another cannot prevent the buyer from making use of that which has been sold to him.
>
> This principle, however, finds no application in the present situation, because Shearer did not sell or grant any license to the Government. This court in its former opinion merely held that Shearer was estopped to assert his launching apparatus patent because the details covered by the valid claims therein were developed at Government expense, the Government therefore inferentially obtaining a shop right or implied license to use the launching apparatus."

This ruling presents no question of law meriting consideration by this Court. It is submitted that the Court of Claims did not err, in matter of law or fact, in thus disposing of the defendant's contention as to a resulting license.

Apportionment.

The question as to the amount of compensation, to be awarded plaintiff for the unlicensed use of the invention covered by claims 3 and 6 of his patent, No. 1,173,879, is one of fact. On the accounting, the Court of Claims found

(Finding 12) that the willow mat revetment previously used by the Government, very extensively, was a reasonable standard of comparison by means of which the Shearer inventions might be evaluated. Using the willow mat revetment as a standard of comparison with the patented articulated concrete revetment, it was found (Findings 13 and 14) that the use of the Shearer inventions, covered by the revetment patent, No. 1,173,879, and the launching boat patent, No. 1,229,152, resulted in a saving in cost to the Government of $2.68 per square. The Court of Claims found (Findings 20 and 21) that other advantages, due to the use of these inventions as compared to the willow mat, resulted in a benefit evaluated at $0.32 per square, making a total fair and reasonable monetary value for the benefits derived by the United States from the two Shearer inventions, of $3.00 per square. It found that a reasonable allocation of this sum, between the launching apparatus and the revetment patents, resulted in allocating the sum of $1.81 per square, as the value of the advantages due to the revetment patent, No. 1,173,879. It, then, found (Finding 22) that a fair and reasonable figure, upon which to base compensation to the plaintiff, was 20% of this monetary value of $1.81 per square. Appellant challenges this finding of fact and contends that less than 20% should have been adopted as a basis for computing the compensation. It does not suggest what the percentage should have been and there are no findings of fact and no evidence to indicate what the Government considers a reasonable apportionment would be.

In making these findings of fact as to just and reasonable compensation, the Court of Claims did not ignore applicable decisions of this Court. On the contrary, it followed the decisions which hold that, where the patented invention is of a novel combination of elements, and the salability or utility of an article is primarily due to the

combination, the patentee is entitled to recover the entire value of the advantages of this new combination as compared with what was available in the prior art. The Court of Claims disposed of this argument by the Government, as follows (Preprint, p. 21):

> "We have made this comparison not for the purpose of sustaining validity, which we have already determined, but in connection with the method used in the accounting and to which defendant objects. The defendant urges that the Shearer revetment patent was not for an articulated concrete mat *per se*, but that his invention was merely an improvement over the prior art mat such as the Hawkes mat, and that it only consisted in the improved method of attaching the launching cables to the concrete blocks. On this basis defendant urges that plaintiff has ignored the established rule of apportionment, which places upon a plaintiff in a patent accounting the burden of apportioning the value of that part of the structure covered by his invention as against that which was open to defendant to use, and that plaintiff having failed to properly apportion the value of the cables and their attachment to the launching blocks, has failed to establish a satisfactory basis for an accounting.
>
> While we have used apportionment in the accounting as between the revetment patent and the launching apparatus patent, to which the defendant contributed, we do not think that the apportionment rule applies to the groups of elements specified in claims 3 and 6 of the Shearer revetment patent. These claims cover a novel combination of elements, even though some of them are individually old. There is here no basis for an attempt to segregate patented elements from unpatented elements. The pith of the invention is the entire cooperative combination and not some special details of construction. The Hawkes mattress was not of any value to the Government because its construction was such that it could not be laid in deep water and swift current. The combination of elements expressed in the

claims of the revetment patent, to quote from our former opinion in this case, 'solved the problem' and thus enabled subaqueous articulated concrete revetments to be used.

This case therefore comes within the entire value rule in which the salability or utility of an article is primarily due to the improvement imparted to the combination. See *Hurlbut v. Schillinger*, 130 U. S. 456; *Crosby Valve Co. v. Safety Valve Co.*, 141 U. S. 441; *Piaget Novelty Co. v. Headley et al.*, 123 Fed. 897.

In the *Hurlbut v. Schillinger case*, above cited, the patent was directed to a concrete pavement laid in detached blocks or sections, so that one section could be removed without disturbing the adjacent sections. Concrete pavements were in themselves old, but the Supreme Court said, with respect to the sectionalizing of concrete pavements that—

> 'The invention of Schillinger was a very valuable one. The evidence is that it entirely superseded the prior practice of laying concrete pavements in a continuous, adhering mass. * * * It clearly appears that the defendant's concrete flagging derived its entire value from the use of the plaintiff's invention, and that if it had not been laid in that way it would not have been laid at all.' "

It is submitted that these findings, as to what would be a just and reasonable compensation to Shearer, do not involve any question of law meriting consideration by this Court, and that the Court of Claims committed no error of fact or law in determining the amount of compensation.

Interest.

The Court of Claims found, as a fact, that the reasonable and just compensation to plaintiff, for the unlicensed use of his patented invention, was the sum of $319,673.16, plus interest on specified amounts from specified dates "this amount not being added as interest but as a part of the just

compensation" (Finding 23). In making this finding of fact as to the amount of compensation, the Court of Claims did not disregard the decision of this Court in *Goltra* v. *United States,* 312 U. S. 203. That decision had been considered in the briefs of both parties. That was a case where the taking had been held not to be tortious and, therefore, no interest was allowed, since the special act in that case made no reference to interest. However, in the *Goltra* case, this Court distinguished from the case of recovery of compensation for the appropriation of a property right by the Government. The Government's unlicensed use of the invention patented to Shearer was a tort. Shearer could have recovered for this tort by suit in the Court of Claims under the Act of June 25, 1910, as amended by the Act of July 1, 1918, but for the fact of his employment in the Government service. The United States had not consented to be sued for the tort, by one in its service or employment, but, nevertheless, infringement of the patent was an appropriation of a property right owned by Shearer. The Special Act, in this case, merely removed the bar to suit, arising from Shearer's employment by the Government and permitted the adjudication of the case by the Court of Claims, as other patent cases are under patent law. That was recognized by the decision of the Court of Claims, on the accounting (Preprint, p. 25), where it said:

> "In its former decision in the present case (87 C. Cls. 40) the court held that—
>
> > 'The report of the Committees having under consideration the special act in this case indicates that Congress intended no more than to refer the case to this court to be adjudicated as other patent cases are under patent law.'
>
> Interest is therefore included not as interest but as part of the entire compensation in accordance with

Harry F. Waite v. The United States, 69 C. Cls. 153; 282 U. S. 508."

It is submitted that this ruling presents no erroneous decision of a question of law, requiring consideration by this Court.

Validity.

The validity of Shearer patent, No. 1,173,879, is not now a matter of public interest, in view of the expiration of that patent over eleven years ago. There are no conflicting decisions as to the validity of said patent. Whether the subject-matter covered by claims 3 and 6 of this patent was new and useful, and an invention, are questions of fact. These facts were found by the Court of Claims in favor of plaintiff, as follows (Preprint, p. 28):

> "40. There is no disclosure in the prior art of a flexible concrete mattress having the structure defined in claims 3 and 6 of the patent in suit. This structure was not obvious and arose above mere mechanical skill. The prior art shows that those skilled in the art who were attempting to solve the problem of using concrete in reveting subaqueous banks failed to perceive its value and the advantages it afforded.
>
> "41. Claims 3 and 6 of patent No. 1173879 define a new and useful art, machine, manufacture, or composition of matter, or a new and useful improvement thereof, not known or used by others in this country, and not patented or described in any printed publication in this or any foreign country before plaintiff's invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, and of which the plaintiff was in fact the original, first, and sole inventor."

The holding by the Court of Claims that the revetment patent, No. 1,173,879, was valid did not conflict with the

rule laid down by this Court in *Atlantic Works* v. *Brady*, 107 U. S. 192, as contended by appellant. In the present case, it was found that the invention covered by claims 3 and 6 of the Shearer patent was not one "which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures". It is submitted that the holding of validity is wholly supported by Findings of Fact, Nos. 40 and 41, and that such holding cannot be disturbed without setting aside said findings as unsupported by the evidence. Appellant has not suggested that these findings lack support in the evidence, and could not do so.

CLARENCE B. DES JARDINS,
3208-11 Carew Tower, Cincinnati, Ohio,
Attorney for Appellee.

August 8, 1944.